



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/234,485	01/21/1999	SHUJI OTSUKA	102624	6019

25944 7590 01/29/2004

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 01/29/2004

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/234,485

Applicant(s)

OTSUKA ET AL.

Examiner

Joseph R. Pokrzywa

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7-13 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-13 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 12/30/03, and has been entered and made of record. Currently, **claims 1-3, 5, 7-13, and 18** are pending.
2. Upon conducting a subsequent search, the examiner discovered a new reference of Ryan (U.S. Patent Number 6,559,979), which can be interpreted as anticipating each of the claims.
3. Thus, the indicated allowability of **claims 1-3, 5, 7-13, and 18** is withdrawn in view of this newly discovered reference to Ryan. Rejections based on the newly cited reference follow.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-3, 5, 7-13, and 18** are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan (U.S. Patent Number 6,559,979).

Regarding **claim 1**, Ryan discloses a facsimile system (see Figs. 4 and 5) comprising a facsimile machine reading image data from an original (scanner 105 in facsimile 10, see Figs. 1, 4 and 5), a computer transmitting to and receiving from the facsimile machine data of addressee identification information (see Fig. 6) indicative of at least a name of addressee and a facsimile

Art Unit: 2622

number corresponding to the name of addressee (column 3, line 58 through column 4, line 17), computer-side storage means provided at a computer side (personal computer 50) for storing the data of addressee identification information (NVRAM 505, column 3, lines 58 through 65), computer-side referring means provided at the computer side for fetching the data of addressee identification information from the computer-side storage means (column 5, lines 23 through 48), computer-side output means for outputting the fetched data of addressee identification information to the facsimile machine in case of facsimile transmission so that the facsimile transmission is executed according to a desired piece of addressee identification information selected from the fetched data of addressee identification information (column 5, lines 49 through 58, and column 6, lines 18 through 39, being step P19 in Fig. 7), instruction means provided in the facsimile machine so as to instruct the computer at the facsimile machine side to refer via the computer-side referring means to the data of addressee identification information stored in the computer-side storage means in case of facsimile transmission (operation panel 14, with ten-key set 141, see Figs. 1, 3, and 5), and a display means for displaying the data of addressee identification information fetched by the computer-side referring means in case of facsimile transmission so that the desired piece of addressee identification information is selected at the facsimile side (see Fig. 8).

Regarding *claim 2*, Ryan discloses the system discussed above in claim 1, and further teaches that the facsimile machine (facsimile machine 10, seen in Fig. 5) includes facsimile-side input means provided so that the data of addressee identification information output is received in the facsimile machine (column 6, lines 25 through 45) and facsimile-side storage means

Art Unit: 2622

(NVRAM 153) for storing the data of addressee identification information supplied to the facsimile-side input means (column 6, lines 29 through 39).

Regarding *claim 3*, Ryan discloses the system discussed above in claim 2, and further teaches that the facsimile machine (facsimile machine 10, seen in Fig. 5) includes means for registering the data of addressee identification information in the facsimile-side storage means (column 3, lines 5 through 38, and column 6, lines 29 through 39) and facsimile-side output means for outputting the data of addressee identification information registered in the facsimile-side storage means by the facsimile-side registering means (column 5, lines 37 through 58), the computer (personal computer 50) includes computer-side input means for receiving the data of addressee identification information output from the facsimile-side storage means by the facsimile-side output means (column 5, lines 46 through 52), and the computer-side storage means stores the data of addressee identification information received by the computer-side input means (column 5, line 46 through column 6, line 24).

Regarding *claim 5*, Ryan discloses the system discussed above in claim 2, and further teaches that the facsimile machine (facsimile machine 10) includes a means for inputting information about the name of addressee contained in the data of addressee identification information and instructing to retrieve the data of addressee identification information corresponding to the input information (column 3, lines 5 through 17, and column 6, lines 40 through 49), the computer-side referring means retrieves the data of addressee identification information stored in the computer-side storage means based on instruction delivered by the retrieval instructing means (column 5, line 23 through column 6, line 24), thereby extracting the corresponding data of addressee identification information (column 5, lines 49 through 64), the

Art Unit: 2622

computer-side output means outputs to the facsimile machine results of extraction by the computer-side referring means (column 6, lines 6 through 28), and the display means includes facsimile-side display means provided at the facsimile side for displaying the results of extraction output by the computer-side output means to thereby be received by the facsimile-side input means (LCD indicator 147, column 3, lines 5 through 17).

Regarding **claim 7**, Ryan discloses the system discussed above in claim 5, and further teaches that the display means includes computer-side display means provided at the computer side (display 507) for displaying results of extraction an amount of which is larger than one of the results of extraction displayed by the facsimile-side display means (see Figs. 3 and 8, column 3, lines 14 through 17, and column 5, lines 49 through 64).

Regarding **claim 8**, Ryan discloses the system discussed above in claim 2, and further teaches that the facsimile machine (facsimile machine 10) includes means for selecting the data of addressee identification information stored in the facsimile-side storage means (column 3, lines 5 through 17) and at least one of the data of addressee identification information stored in the computer-side storage means (column 3, line 58 through column 4, line 64), with the one of the data being the one referred to by the computer-side referring means (column 5, lines 37 through 64), and transmission means for transmitting image data to an addressee indicated by the data of addressee identification information selected by the selecting means either via a communication channel by way of an internet or via a public communication network not by way of the internet (column 3, lines 18 through 25, and column 4, lines 1 through 64).

Regarding **claim 9**, Ryan discloses the system discussed above in claim 8, and further teaches that each of the facsimile-side storage means (NVRAM 153) and the computer-side

Art Unit: 2622

storage means (NVRAM 505) is capable of storing data of a mail address specifying an addressee of an electronic mail (column 4, lines 12 through 18) as the data of addressee identification information (column 6, lines 18 through 39), and the transmission means transmits image data to an addressee specified by the mail address via the communication channel by way of the internet when the data of addressee identification information is the mail address (column 3, lines 39 through 48, and column 4, lines 12 through 64, wherein an e-mail message is sent to an e-mail address, shown in Fig. 6, over the public communication network 80, which inherently includes the internet).

Regarding *claim 10*, Ryan discloses the system discussed above in claim 1, and further teaches that the facsimile machine (facsimile machine 10) is capable of executing facsimile transmission via an internet to an addressee (column 3, lines 39 through 48, and column 4, lines 12 through 64, wherein an e-mail message is sent to an e-mail address, shown in Fig. 6, over the public communication network 80, which inherently includes the internet), and the facsimile machine includes reading means for reading data of address information registered on the basis of an electronic mail application program which is already in operation (column 4, lines 12 through 17, and column 5, lines 23 through 48) and designating means for designating the data of address information read by the reading means as data of address information for the facsimile transmission via the internet (column 3, lines 39 through 48, and column 4, lines 12 through 64, whereby the public communication network 80 inherently includes the internet).

Regarding *claim 11*, Ryan discloses the system discussed above in claim 10, and further teaches that the facsimile machine includes address information storage means (NVRAM 153) for storing the data of address information designated by the designating means as an addressee

Art Unit: 2622

address for the facsimile transmission via the internet (see Fig. 6, column 4, lines 12 through 17, and column 6, lines 29 through 39) and address selecting means for selecting a desired address from the address information storage means (column 4, lines 21 through 64).

Regarding *claim 12*, Ryan discloses the system discussed above in claim 10, and further teaches that the electronic mail application program is in operation on the computer of the system or a computer other than the computer of the system (column 5, line 30 through column 6, line 39).

Regarding *claim 13*, Ryan discloses the system discussed above in claim 11, and further teaches that the electronic mail application program is in operation on the computer of the system or a computer other than the computer of the system (column 5, line 30 through column 6, line 39).

Regarding *claim 18*, Ryan discloses a facsimile system (see Figs. 4 and 5) comprising a facsimile machine reading image data from an original (scanner 105 in facsimile 10, see Figs. 1, 4 and 5), a computer transmitting to and receiving from the facsimile machine data of addressee identification information (see Fig. 6) indicative of at least a name of addressee and a facsimile number corresponding to the name of addressee (column 3, line 58 through column 4, line 17), a computer-side storage circuit provided at a computer side (personal computer 50) for storing the data of addressee identification information (NVRAM 505, column 3, lines 58 through 65), a computer-side referring circuit provided at the computer side for fetching the data of addressee identification information from the computer-side storage circuit (column 5, lines 23 through 48), computer-side output circuit for outputting the fetched data of addressee identification information to the facsimile machine in case of facsimile transmission so that the facsimile

Art Unit: 2622

transmission is executed according to a desired piece of addressee identification information selected from the fetched data of addressee identification information (column 5, lines 49 through 58, and column 6, lines 18 through 39, being step P19 in Fig. 7), an instruction circuit provided in the facsimile machine so as to instruct the computer at the facsimile machine side to refer via the computer-side referring circuit to the data of addressee identification information stored in the computer-side storage circuit in case of facsimile transmission (operation panel 14, with ten-key set 141, see Figs. 1, 3, and 5), and a display means for displaying the data of addressee identification information fetched by the computer-side referring circuit in case of facsimile transmission so that the desired piece of addressee identification information is selected at the facsimile side (see Fig. 8).

Citation of Pertinent Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Ouchi (U.S. Patent Number 5,798,848) discloses a system having a facsimile machine and a computer, whereby the computer registers address numbers for the facsimile machine.

Art Unit: 2622

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



Joseph R. Pokrzywa

Examiner

Art Unit 2622

EDWARD COLES

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

jrp